

Remarks

Status of the Claims

Concurrent with a Request for Continued Examination (“RCE”) under 37 CFR § 1.114, this paper is filed in response to the Office Action mailed September 20, 2007, in which claims 1, 2, 5-22, 25-42, and 45-70 were pending in the application. All pending claims stand rejected. By this paper, claims 1, 5, 6, 21, 25, 26, 41, 45, 46, 61-64, 69, and 70 have been amended and claims 20, 40, and 60 have been cancelled. For at least the reasons set forth below, Applicant submits that each of the pending claims is patentably distinct from the cited prior art and in condition for immediate allowance. Reconsideration of the claims is therefore respectfully requested.

Claim Objections

Claims 5-7, 25-27, 45-47, 69, and 70 stand objected to due to various informalities. Applicant thanks the Examiner for identifying these informalities and submits that the amendments presented herein are sufficient to overcome the objections. Applicant therefore respectfully requests that these claim amendments be withdrawn.

Specification

The Examiner has objected to the specification on the basis that the amendment filed on July 2, 2007 introduced new matter into the disclosure. Applicant respectfully disagrees. The matter introduced by way of the above-referenced amendment was fully supported by the original claims. An applicant may amend the specification to include

subject matter set forth in the originally-filed claims. MPEP § 2163.06 (III). The Examiner purports to reject this doctrine on the basis that the independent claims from which claims 20, 40, and 60 depend have been amended. However, any amendments to claims 1, 21, and 41 do not change the fact that the subject matter of claims 20, 40, and 60 was disclosed in the original application. This subject matter was added to the specification, as permitted by Section 2163.06 (III) of the Manual of Patent Examining Procedure and related case law. In other words, despite the fact that claims 20, 40, and 60 are technically no longer “original claims,” the subject matter set forth in these claims was part of the original disclosure, regardless of any amendments that may have been entered vis-à-vis their corresponding independent claims in the interim.

Despite Applicant’s traversal of the Examiner’s objection to the specification, in order to avoid any further delay to issuance of the application, Applicant has amended the specification to remove the allegedly new subject matter, without prejudice to its being reintroduced via amendment or in a continuation application. Applicant therefore respectfully requests withdrawal of the objection.

Claim Rejections – 35 U.S.C. § 112

Claims 20, 40, and 60 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. For at least the reasons set forth in the above section, Applicant also traverses these claim rejections. However, to avoid any further delay to issuance of the application, Applicant has cancelled each of these rejected claims without prejudice to their reintroduction via amendment or a

continuation application. Applicant therefore respectfully requests withdrawal of these claim rejections.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 2, 6-12, 14-22, 26-32, 34-42, 46-52, 54-60, and 63 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,710,591 issued to Bruno et al. (“Bruno”). However, for at least the reasons set forth below, Applicant respectfully requests reconsideration of these claim rejections.

Bruno discloses a system for recording and indexing content from a videoconference. As mentioned in the previous response, Bruno does disclose participation in the videoconference by voice-only participants. However, Bruno contains no disclosure whatsoever regarding storing a video signal in response to a determination being made that a connected device is not capable of receiving video signals. To the contrary, Bruno very explicitly discloses that only those conference call participants (“accessors”) that have video capability will be able to receive and view a video signal. See, e.g., col. 9, lines 55-57 (“Of course, if the accessor does have video capability, then video information can be retrieved as well.”) (emphasis added); col. 9, lines 44-48 (indicating that “if the accessor does not have video capability at his workstation, the accessor may only receive data, audio and/or text . . . from the stored multimedia conference record”).

The Examiner does not dispute that the signals of Bruno are recorded regardless of whether any of the participants have non-video-enabled communication devices. Nevertheless, the Examiner purports to interpret the language “in response to

determining that the second [or non-video-enabled] device is not capable of displaying the captured video signals, caching . . ." as encompassing the Bruno system. Stated otherwise, the Examiner purports to interpret claim language requiring the performance of a caching operation "***in response to***" determining that a device is not video-enabled as encompassing a system that caches regardless of the presence or non-presence of a non-video-enabled device.

Applicant respectfully submits that this is an unreasonable interpretation of the claim language which ignores the phrase "in response to." Applicant has explicitly claimed a link between an operation of the claimed system (caching) and the presence of a factual determination (a connected device being non-video enabled). A system that caches irrespective of this factual determination lacks this claimed link. More to the point, Bruno clearly lacks this claimed link. Indeed, Bruno's caching operation has nothing whatsoever to do with the presence, or lack thereof, of a non-video-enabled device.

Applicant offers as an analogy a hypothetical claim for an automated lawn mowing system having claim language that recites a lawn mowing operation which is performed "in response to" detecting grass that exceeds a particular length. Surely such a claim would not be considered anticipated by a prior art reference disclosing a mowing system that mows on a set schedule, such as once a week, regardless of the length of the grass. Such a prior art system would be inferior in many respects because the lawn may be mowed on many occasions by the prior art system when it need not be, due to, for example, variable growth rates in different months or seasons. Similarly, Applicant's claimed invention provides advantages over the Bruno system because it

only stores signals in response to a determination being made that at least one participant in a communication has a non-video-enabled device, rather than wasting memory by storing video signals that have already been viewed by each participant in the video conference.

Despite Applicant's traversal of these claim rejections, Applicant has amended each of the pending independent claims herein to recite, in one form or another, that the caching is not performed unless a determination is made that the second device is not capable of displaying the captured video signals. Applicant believes this to be an inherent limitation of the previous claim language and therefore notes that these amendments should be considered non-narrowing. Nevertheless, Applicant has submitted these claim amendments in order to clarify the claim language and avoid any further delay to issuance of the application.

The claim amendments presented here explicitly and necessarily exclude Bruno. Indeed, because Bruno discloses a system that caches video signals regardless of whether any of the participants have non-video-enabled communication devices, it teaches precisely the **opposite** of a system that **does not** cache unless a determination is made that a non-video-enabled device is present. Thus, for at least the foregoing reasons, each of the pending independent claims is patentably distinct from the cited prior art. Applicant therefore respectfully requests that these claim rejections be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 5, 25, and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruno in view of U.S. Patent No. 6,289,346 issued to Milewski et al. Claims 13, 33, 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruno. Claims 61, 62, and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruno in view of U.S. Patent No. 6,151,490 issued to Schultheiss.

Each of these rejected claims was either amended to clarify the distinction with Bruno, as discussed above, or depends from a claim that was so amended. Accordingly, for at least the reasons set forth above, each of the claims rejected under 35 U.S.C. § 103 is also patentably distinct from the cited prior art. Applicant therefore respectfully requests that these claim rejections also be withdrawn.

Conclusion

In view of the foregoing, all pending claims represent patentable subject matter. A Notice of Allowance is respectfully requested.

Respectfully submitted,

Digeo, Inc.

By Kory D. Christensen/
Kory D. Christensen
Registration No. 43,548

STOEL RIVES LLP
One Utah Center Suite 1100
201 S Main Street
Salt Lake City, UT 84111-4904
Telephone: (801) 328-3131
Facsimile: (801) 578-6999